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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,419	05/11/2001	Thomas J. Moravec	589.102US1	7680

7590 03/05/2003

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EXAMINER

RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/854,419

Applicant(s)

MORAVEC ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 December 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-17 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) 11,12 and 20-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-17 and 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of claims 1-10 and 13-19 in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Interpretation***

2. The phrase, "sandwiched between" in line 5 of newly amended claim 1 means, "directly adhered to" and precludes the presence of a material between the photochromic layer and the polymer layers. The examiner is relying on the common use of the phrase for its definition.

### ***Claim Rejections - 35 USC § 112***

3. The amendment filed December 26, 2002 overcomes the rejections made under this heading in paragraphs 10 and 11 of the office action dated September 2, 2002.

4. The rejection made under this heading in paragraph 12 of the office action dated September 2, 2002 is maintained (see paragraph 8 of this office action).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 4-7, 9-10, 17, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 4-7, 9-10, 17, and 19 ultimately depend from cancelled claim 2. Since the limitations of original claim 2 are included in newly amended claim 1, these claims will be interpreted as if they ultimately depend from newly amended claim 1, as the examiner believes this to be the applicant's intended claim language. The examiner will do so by interpreting claims 4-5 and 9 as depending from claim 1 instead of claim 2.

8. Claims 8-10 are further rejected under this heading because the examiner is not sure what laminate structure the applicant is claiming. The applicant appears to be attempting to claim an additional layer between the polymeric layers, but the current claim language precludes such a structure. The examiner is not sure if the applicant means to claim an additional layer coated on the polymeric layers or if the applicant's intent would be more accurately conveyed by new independent claims. For the purposes of the current examination, the claims will be interpreted to mean that scratch resistant layers, anti-fogging layers, tint layers, or hydrophobic layers are included in the multilayer structure.

***Claim Rejections - 35 USC § 102***

9. The amendment filed December 26, 2002 overcomes the rejection made under this heading in the office action dated September 2, 2002.

***Claim Rejections - 35 USC § 103***

10. The amendment filed December 26, 2002 overcomes the rejection made under this heading in paragraph 17 of the office action dated September 2, 2002.

11. Claims 1, 3-10, 13-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhalakia et al. in view of Ormsby et al.

The office action dated September 2, 2002 contains the text of this rejection, which is restated below.

Bhalakia et al. discloses a multifocal optical lens that includes the general laminable structure of the present invention – up to two polycarbonate sheets (column 10, line 32) that have a multilayer functional film (column 5, lines 7-10), such as a photochromic film, sandwiched between them (column 4, lines 11-15). These are restrictions in the applicant's claims 1 and 3. The multilayer functional film is securely adhered to the polymeric substrates (the article in the present claims) via lamination (column 16, line 5), meeting this method requirement in claims 4-5, 13-17, and 19.

Bhalakia et al. teaches that the polymeric substrates can be in the form of ophthalmic lenses (column 4, line 59), which meets this restriction in claims 6 and 7,

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and may also include an anti-abrasion coating (column 6, lines 55-58 and column 7, line 2), meeting this part of claims 8-10.

Claims 4 and 5 are product-by-process claims. In product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102 or 103 rejection made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. The applicant has not shown that the method by which the product is made causes the product to be patentably distinct from the product produced by the reference(s). Specifically, any structure that contains the elements in claims 4 and 5 where the laminable photochromic element is securely deposited on a polymeric surface will be the same as the element in these claims, regardless of if they are or are not fused or adhesively secured to the substrate. This rejection under 35 U.S.C. 103 is therefore proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Bhalakia et al. does not, however, meet the material restriction of claim 1 which includes a polyester urethane binder and a photochromic compound, though it does note that the composition of the functional portion of the invention may be changed to suit various applications (column 19, lines 63-66).

Ormsby et al. shows a polyurethane binder that includes photochromic compounds (column 4, lines 3-12). The polyurethane binder is a polyester urethane, made from polyester diols and polyisocyanates (column 3, line 41), and is used in ophthalmic lenses (column 2, lines 60-61) as part of a multilayer laminate structure

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(column 2, lines 56-59). This meets the compositional requirements for the polyurethane binder in the applicant's claim 1.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the photochromic polyurethane composition in Ormsby et al. in the functional layer in Bhalakia et al. or the multilayer structure in Ormsby et al. as the functional layer in Bhalakia et al. The motivation for doing so would be that the photochromic polyurethane composition in Ormsby et al. is known to be a good intermediate layer for photochromic lenses. Therefore it would have been obvious to combine Ormsby et al. with Bhalakia et al. to obtain the invention as specified in claims 1, 3-10, 13-17, and 19.

12. Claims 1, 3-10, 13-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhalakia et al. in view of Rosthauser et al.

The office action dated September 2, 2002 contains the text of this rejection, which is restated below.

Bhalakia et al. and its deficiencies are discussed in paragraph 11 of this office action. Rosthauser et al. discloses a polyester urethane binder (column 3, lines 8-40) that contains a photochromic compound (column 4, lines 16-24). The polyester urethane composition is used in ophthalmic lenses (column 1, lines 19-2), among other uses.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the photochromic polyurethane composition in Rosthauser et al. in

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the functional layer in Bhalakia et al. The motivation for doing so would be that the photochromic polyurethane composition in Rosthauser et al. is known to be a good intermediate layer for photochromic lenses. Therefore it would have been obvious to combine Rosthauser et al. with Bhalakia et al. to obtain the invention as specified in claims 1-10 and 13-19.

### ***Response to Arguments***

13. Applicant's arguments filed December 26, 2002 have been fully considered but they are not persuasive.

14. The applicant appears to argue that Bhalakia et al. does not meet the present invention because it does not pertain to photochromic multilayers. This is not persuasive because the functional layer in the multilayer in Bhalakia et al. is taught to be photochromic (column 5, line 26). Further, the applicant also appears to argue that the multilayer in Bhalakia et al. is not the same multilayer the applicant claims. The examiner respectfully disagrees, as Bhalakia et al. discloses a multilayer structure that is laminable to ophthalmic lenses (see the above description of the reference).

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
February 19, 2003

A handwritten signature in black ink, appearing to read 'James J. Seidleck', is positioned above the printed name.

James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700